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09/826,888	04/06/2001	Hisashi Hotta	003510-091	3377

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Platon N. Mandros  
BURNS, DOANE, SWECKER & MATHIS, L.L.P.  
P.O. Box 1404  
Alexandria, VA 22313-1404

EXAMINER

HAMILTON, CYNTHIA

ART UNIT	PAPER NUMBER
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1752

DATE MAILED: 02/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/826,888

Applicant(s)

HOTTA, HISASHI

Examiner

Cynthia Hamilton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1 is/are allowed.
- 6) ☒ Claim(s) 2-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 07/09/2004.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. Claim 1 is allowed in view of applicant's amendment made to limiting the recording layer to comprising an infrared absorbing agent and a polymer insoluble in water and soluble in alkaline water. This limitation removes the prior art of record drawn to silver layers wherein the binders are soluble in water.

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 2- 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jonckheere, (EP 0 716 935). With respect to instant claims 2-5, the lithographic printing plates of Jonckheere teach all of the instant plate of claim 1 and the plate of claims 2-5 wherein the (1) option of density from 1.0 g/cm<sup>3</sup> to 3.2 g/cm<sup>3</sup> of the anodic oxidation coating is chosen with the exception of teaching the specific density range of from 1000 to 3200 kg/m<sup>3</sup>, i.e. 1.0 g/cm<sup>3</sup> to 3.2 g/cm<sup>3</sup>, and an example using the infrared lasers for imaging. However, Jonckheere teaches the formation of their plates for use in imaging with near infra-red lasers on page 6, lines 31-35, and the range of layer thickness, i.e. 0.4 to 2.0 μm in last paragraph on page 3 of Jonckheere, and anodized film weight of 1-8 g/m<sup>2</sup> in the paragraph in Jonckheere bridging pages 5-6. Thus, with respect to instant claims 2-5, the plates of Jonckheere make prima facie the instant plates wherein the theoretical density range of the anodic oxide layer in Jonckheere of 500 kg/m<sup>3</sup> to 20,000 kg/m<sup>3</sup> overlaps the instant range. The calculation should be as follows:

$$(1 \text{ g/m}^2)(1/2 \text{ μm})(1 \text{ kg}/1000\text{g})(1 \times 10^6 \text{ μm}/\text{m}) = 500 \text{ kg/m}^3.$$

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This is for (1 g/m<sup>2</sup>) and 2 μm thickness of the lightest possible layer set forth by the ranges of EP 0697282 on page 7. The most dense layer would be (8 g/m<sup>2</sup>) and 0.4 μm. The density would be as follows:

$$(8 \text{ g/m}^2)(1/0.4 \text{ μm})(1 \text{ kg}/1000\text{g})(1 \times 10^6 \text{ μm/m}) = 20,000 \text{ kg/m}^3.$$

The one plate in Example 1 of Jonckheere has no thickness given but when calculated within the range of thickness range disclosed has 1,300 to 6,500 20,000 kg/m<sup>3</sup> range of possible density.

This range also overlaps the instant range claimed. In the case where the claimed ranges “overlap or lie inside ranges disclosed by the prior art” a *prima facie* case of obviousness exists.

*In re Werthheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976); *In re Woodruff*, 919 F.2d 1575, 16 UAPQ2d 1934 (Fed. Cir. 1990). See particularly MPEP 2144.05.

3. Claims 2- 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over de Jaeger et al (EP 0 730 202 A2). With respect to instant claims 2-5, the lithographic printing plates of de Jaeger et al teach all of the instant plate of claims 2-5 wherein the (1) option of density from 1.0 g/cm<sup>3</sup> to 3.2 g/cm<sup>3</sup> of the anodic oxidation coating is chosen with the exception of teaching the specific density range of from 1000 to 3200 kg/m<sup>3</sup>, i.e. 1.0 g/cm<sup>3</sup> to 3.2 g/cm<sup>3</sup>, and an example using the infrared lasers for imaging. However, de Jaeger et al teaches the formation of their plates for use in imaging with near infra-red lasers on page 9, lines 33-37, and the range of layer thickness, i.e. 0.4 to 2.0 μm in second paragraph on page 7 of de Jaeger et al, and anodized film weight of 1-8 g/m<sup>2</sup> in the first paragraph in de Jaeger et al of page 8. Thus, with respect to instant claims 2-5, the plates of de Jaeger et al make *prima facie* the instant plates wherein the theoretical density range of the anodic oxide layer in Jonckheere of 500 kg/m<sup>3</sup> to 20,000 kg/m<sup>3</sup> overlaps the instant range. The calculation should be as follows:

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$$(1 \text{ g/m}^2)(1/2 \text{ }\mu\text{m})(1 \text{ kg}/1000\text{g})(1 \times 10^6 \text{ }\mu\text{m}/\text{m}) = 500 \text{ kg/m}^3.$$

This is for  $(1 \text{ g/m}^2)$  and  $2 \text{ }\mu\text{m}$  thickness of the lightest possible layer set forth by the ranges of de Jaeger et al. The most dense layer would be  $8 \text{ g/m}^2$  and  $0.4 \text{ }\mu\text{m}$ . The density would be as follows:

$$(8 \text{ g/m}^2)(1/0.4 \text{ }\mu\text{m})(1 \text{ kg}/1000\text{g})(1 \times 10^6 \text{ }\mu\text{m}/\text{m}) = 20,000 \text{ kg/m}^3.$$

The one plate in Example 1 of de Jaeger et al has no thickness given but when calculated within the range of thickness range disclosed has 1,300 to 6,500  $20,000 \text{ kg/m}^3$  range of possible density.

This range also overlaps the instant range claimed. In the case where the claimed ranges “overlap or lie inside ranges disclosed by the prior art” a *prima facie* case of obviousness exists.

*In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976); *In re Woodruff*, 919 F.2d 1575, 16 UAPQ2d 1934 (Fed. Cir. 1990). See particularly MPEP 2144.05.

4. Applicant's arguments filed November 23, 2004 have been fully considered but they are not persuasive. Applicants argue that they have shown the narrowed range of

(i) density from  $1.0 \text{ g/cm}^3$  to  $3.2 \text{ g/cm}^3$  determined immediately after said anodic oxidation coating is disposed on the substrate, and

over Jonckheere, or de Jaeger et al

(EP 0 730 202 A2) in their comparisons, but because Jonckheere and de Jaeger et al are drawn to infrared recording layers of silver halide, applicant's showings are not commensurate in scope with the scope of the claimed invention. There is no showing to infrared recording layers with silver halide recording layers. The rejections stand.

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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3. Claims 2-21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The removal of "after developing process" from the limit to contact angle of a non-image area of the anodic oxidation coating in instant claim 2 leaves unclear whether the now claimed printing plate of claims 2-21 is supported by the original disclosure. The original claim 2 is as follows:

2. A planographic printing plate comprising a recording layer writable by exposure to an infrared laser, said recording layer provided on a support, the support including an aluminum substrate comprising a roughened surface including an anodic oxidation coating disposed thereon, and the anodic oxidation coating being at least one of:

(i) density from 1000 kg/m<sup>3</sup> to 3200 kg/m<sup>3</sup>, or

(ii) micropores exposed on the surface of anodic oxidation coating including diameters of not more than 15 nm, and a contact angle of a non-image area after a developing process is not more than 20°, the micropores including a vacancy ratio of in percent as follows:

vacancy ratio =  $(1 - (\text{density of anodic oxide coating} / 3.98)) \times 100$

wherein density of anodic oxidation coating (g/cm<sup>3</sup>) = weight of anodic oxidation coating per unit area/thickness of

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the anodic oxide coating and the vacancy ratio is from 20% to 70%.

Claim 2 is now as follows:

Claim 2. (Currently Amended) A planographic printing plate comprising a recording layer writable by exposure to an infrared laser, said recording layer provided on a support, the support including an aluminum substrate comprising a roughened surface including an anodic oxidation coating disposed thereon, the anodic oxidation coating before said recording layer is provided thereon having at least one of:

(i) density from 1.0 g/cm<sup>3</sup> to 3.2 g/cm<sup>3</sup> determined immediately after said anodic oxidation coating is disposed on the substrate, and

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(ii) a vacancy ratio from 20% to 70%, and micropores physically exposed on the surface of the anodic oxidation coating having diameters of not more than 15 nm,

wherein a contact angle of a non-image area of the anodic oxidation coating ~~after a developing process~~ is not more than 20°,

and wherein the vacancy ratio in percent and the density of the anodic oxidation coating before said recording layer is provided are respectively as follows:

vacancy ratio =  $(1 - (\text{density of anodic oxide coating} / 3.98)) \times 100$

density of anodic oxidation coating (g/cm<sup>3</sup>) = weight of anodic oxidation coating per unit area/thickness of the anodic oxide coating.

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Applicants have "noted" that the defined contact angle of the anodic oxidation coating after a development process is the same as that before the recording layer is provided thereon so that the amendment of claim 2 should remove any perceived indefiniteness with respect to the claim.

Applicants have not pointed out where evidence in the original disclosure supports this "noted" equivalence. Thus, while the issue of indefiniteness is removed by this amendment, applicant has not presented sufficient evidence to support their allegation that the contact angle of the anodic oxidation coating after a development process is the same as that before the recording layer is provided thereon. Thus, applicants have failed to show sufficient support in the original disclosure to make clear a worker of ordinary skill in the art would have understood this to be so disclosed in the originally disclosed specification and claims. See particularly MPEP 2163.04.

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claim 2 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 5 and 7 of copending Application No. 10/112729. Although the conflicting claims are not identical, they are not patentably distinct from each other because the plate of the instant claim 2 wherein (i) is the choice of plate wherein



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density from  $1.0 \text{ g/cm}^3$  to  $3.2 \text{ g/cm}^3$  is the same as  $1000 - 32000 \text{ kg/m}^3$  in claims 5 and 7 of copending Application No. 10/112729. The anodic oxide film is in the copending Application is always an aluminum oxide formed on an aluminum plate. Thus, with respect to instant claim 2, the plates of claims 5 and 7 are essentially the same as that claimed by applicants if (i) is chosen.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

6. Claim 2 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2 and 4, and 10-11, and 20-21 of copending Application No. 10/200447. Although the conflicting claims are not identical, they are not patentably distinct from each other because the plate of the instant claim 2 wherein (i) is the choice of plate wherein density from  $1000 - 32000 \text{ kg/m}^3$  in claims 2 and 4, and 10-11, and 20-21 of copending Application No. 10/200447. The anodic oxide film is in the copending Application is always an aluminum oxide formed on an aluminum plate. Thus, with respect to instant claim 2, the plates of claims 2 and 4, and 10-11, and 20-21 are essentially the same as that claimed by applicants if (i) is chosen.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.


7. Because of the new rejections over claim 2 given above with respect to (i)

*Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cynthia Hamilton whose telephone number is 571-272-1331. The examiner can normally be reached on Monday through Friday 9:30 am to 5:00 pm.*

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*If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H Kelly can be reached on (571) 272-0729. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.*

*Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).*

  
**CYNTHIA HAMILTON**  
**PRIMARY EXAMINER**

Cynthia Hamilton  
Primary Examiner  
Art Unit 1752

February 20, 2005